



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,691	02/14/2001	Scott D. Lavender	85706.000017	1658

23387 7590 04/19/2005

Stephen B. Salai, Esq.
Harter, Secrest & Emery LLP
1600 Bausch & Lomb Place
Rochester, NY 14604-2711

EXAMINER

PHAM, THIERRY L

ART UNIT PAPER NUMBER

2624

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,691

Applicant(s)

LAVENDER ET AL.

Examiner

Thierry L Pham

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/20/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 12/20/04.
- Claims 1-29 are pending in application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 11, 19-22, 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Kubo et al (US 6765691).

Regarding claim 1, Kubo discloses a system for scanning a document (scanning system, fig. 1) pursuant to user selected scanning parameters (scanning parameters, fig. 4), the user selected parameters controlling a portion (fig. 4) of the scanning of the document, the system comprising:

- a scanner (scanners 32a-32b, fig. 1) selected to scan the document and produce a scanned image file in accordance with the user selected scanning parameters (scanning parameters, fig. 4);
 - a scanner computer (personal computer 12, fig. 1, col. 12, lines 6-22) connected to the scanner (connects via I/O port 20, fig. 1) to receive the scanned image file from the scanner, the scanner computer having a scanner user interface (main menu user interface 63, fig. 4 and displas via monitor 30, fig. 1) for inputting the user selected scanning parameters (select scanning parameters via user interface as shown in fig. 4);
 - a printer (printer 34, fig. 1) selected to print an image corresponding to the scanned image file;
- and

Art Unit: 2624

- a printer computer (personal computer 12, fig. 1, col. 12, lines 6-22) connected to the printer (personal computer 12 connects to plurality of printers 34 via I/O port 20, fig. 1, col. 12, lines 39-65) and the scanner computer (host computer 12 for controlling both printers and scanners, fig. 1, col. 12, lines 6-67), the printer computer having a printer user interface (printer user interface, fig. 9a-9b) for inputting the user selected scanning parameters.

Regarding claim 2, Kubo further discloses the system of claim 1, wherein the printer computer includes a storage device (HDD 18, fig. 1) for storing the scanned image file.

Regarding claims 3-4, Kubo further discloses the system of claim 1, wherein the printer, the scanner, the scanner computer and the printer computer communicate in a common language (computer and printer languages, i.e., PDL, PCS, PDF and etc and fig. 2).

Regarding claim 11 recites limitations that are similar and in the same scope of invention as to those in claim 1 above; therefore, claim 11 is rejected for the same rejection rationale/basis as described in claim 1.

Regarding claims 19-20 recite limitations that are similar and in the same scope of invention as to those in claims 1-4 and/or combination thereof above; therefore, claims 19-20 are rejected for the same rejection rationale/basis as described in claims 1-4.

Regarding claims 21-22, 26: Claims 21-22, 26 are the method claims corresponding to the apparatus claims 1-4. The method claims are included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 1-4 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2624

Claims 5-10, 12-18, 23-25, 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubo et al (US 6765691), and in view of Fresk et al (US 6421135). Regarding claims 5-6, Kubo discloses Aa document scanning system (fig. 1), comprising:

- a scanner (scanner 32, fig. 1) having an associated scanner user interface (UI, fig. 4); and
- a printer (printer 34, fig. 1) operably connected to the scanner, the printer having an associated printer user interface (fig. 9a), but fails to preclude execution of the scanning parameters prior to execution of previously submitted scanning parameters.

Fresk, in the same field of endeavor for scanning system (fig. 2), teaches the scanner user interface and the printer user interface selected to receive user selected scanning parameters, and to preclude execution of the scanning parameters prior to execution of previously submitted scanning parameters (first come first serve basis, col. 1, lines 35-40).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Kubo as per teachings of Fresk by preclude execution of the scanning parameters prior to execution of previous submitted scanning parameters because of a following reason: (●) to scan and/or print the job requests in the order of received (first come first serve basis).

Therefore, it would have been obvious to combine Kubo with Fresk to obtain the invention as specified in claims 5-6.

Regarding claims 7-10, the combinations of Kubo and Fresk teach scanner user interface (Kubo, fig. 4) and a touch sensitive display screen (touch screen 69, fig. 1, Fresk).

Regarding claims 12-14, 27-29 recite limitations that are similar and in the same scope of invention as to those in claims 5-8 above; therefore, claims 12-14, 27-29 are rejected for the same rejection rationale/basis as described in claims 5-8.

Regarding claims 15-18: Claims 15-18 are the method claims corresponding to the apparatus claims 5-8. The method claims are included by the operation of the apparatus claims.

Please see claims rejection basis/rationale as described in claims 5-8 above.

Art Unit: 2624

Regarding claims 23-25: Claims 23-25 are the method claims corresponding to the apparatus claims 5-8. The method claims are included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 5-8 above.

Response to Arguments

Applicant's arguments filed 12/20/04 have been fully considered but they are not persuasive.

- Regarding claim 1, the applicants argued the cited prior art of record (US 6765691 to Kubo) fails to teach and/or suggest a scanner user interface and printer user interface for inputting user selected scanning parameters.

In response, Kubo explicitly teaches a scanner user interface (main menu user interface 63, fig. 4 and displays via monitor 30 of personal computer) and printer user interface (figs. 9a-9b) for inputting user selected scanning parameters (scanning and printing parameters, fig. 4 and fig. 9 and displays via monitor 30 of personal computer). Please notes, personal computer 12 is for controlling plurality of printers and plurality of scanners.

- Regarding claim 5, the applicants argued the cited prior arts of record (US 6765691 and US 6421135) fail to teach and/or suggest a scanner user interface and printer user interface for inputting user selected scanning parameters and fails to provide motivation to combine.

In response, Kubo explicitly teaches a scanner user interface (main menu user interface 63, fig. 4 and displays via monitor 30 of personal computer) and printer user interface (figs. 9a-9b) for inputting user selected scanning parameters (scanning and printing parameters, fig. 4 and fig. 9 and displays via monitor 30 of personal computer). Please notes, personal computer 12 is for controlling plurality of printers and plurality of scanners. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

Art Unit: 2624

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is "to scan and/or print the job requests in the order of received (first come first serve basis).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. 6256662 to Lo et al, discloses a scanning system implemented with user interface for allowing operators to select scanning parameters.
- US 2001/0052995 to Idehara, discloses a printing system including plurality of printers and digital copy machines (multifunction apparatus) connected to plurality of host computers, and each host computer having a user interface for controlling scanning parameters and printing parameters.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

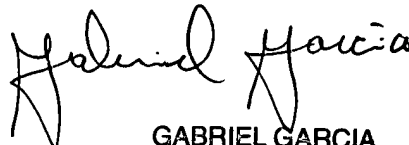
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

Handwritten signature of Thierry L. Pham, consisting of the letters 'TP' in a stylized, cursive script.Handwritten signature of Gabriel Garcia, written in a cursive script.

GABRIEL GARCIA
PRIMARY EXAMINER